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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,269	01/23/2004	Joseph Z. Sleiman	92835-10	5782
22463	7590	12/06/2005	EXAMINER	
SMART AND BIGGAR 438 UNIVERSITY AVENUE SUITE 1500 BOX 111 TORONTO, ON M5G2K8 CANADA			PURVIS, SUE A	
		ART UNIT	PAPER NUMBER	
		1734		

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/762,269	SLEIMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sue A. Purvis	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 12-20 is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 8 recites the limitation "said holes" in line 2. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the examiner will assume claim 8 should depend from claim 2.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al. (US Patent No. 5,291,692).

Regarding claim 1, Takahashi discloses a holder with a face (17) and a plurality of projections (27) projecting outward from the face (17) for maintaining an article (13) at a stand off position from the face. (See Figure 4.)

Regarding claim 2, the face has a plurality of holes (18).

Regarding claim 3, each hole (18) is surrounded by the projections (27) as shown in Figure 4.

Regarding claims 10 and 11, as discussed above, the face in Takahashi includes projections (27) for holding an article in a stand off position. It should be noted that the preamble of these claims has not been given patentable weight because a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Strasbaugh (US Patent No. 5,423,716).

Regarding claim 1, Strasbaugh discloses a handling device which includes a face (54) and a plurality of projections (58) set outward from the face. (See Figures 1 and 2.)

Regarding claims 4 and 5, Strasbaugh discloses circular ridges in Figure 2.

7. Claims 1, 7, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagai et al. (US Patent No. 6,527,323 B2).

Regarding claim 1, Nagai discloses a suction pad or tamper (10) with a face (32) which includes a plurality of projections (34) projecting outward from the surface. (See Figure 8.)

Regarding claims 7, 10, and 11, the cup further comprises flexible accordion sides (22) for allowing the tamper to extend and retract.

Regarding claim 9, the face in Nagai is textured with the projections (32). (See Figures 2, 3, and 4.)

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8. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Avneri et al. (US Patent No. 6,257,564).

Regarding claim 1, Avneri discloses a holder having a surface (120) including a plurality of projections (130, 140, 150) which hold an article at a stand off position.

Regarding claim 6, at least some of the projections in Avneri are domes as seen in Figures 2 and 3A.

#### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strasbaugh as applied to claim 1 above, and further in view of Hofe et al. (US Patent No. 2,723,775).

Regarding claim 2, Strasbaugh discloses single hole, however, Hofe teaches that such a device can have a single hole or designed to have a plurality of holes. (See Figures 3 and 5.) It would have been obvious to one having ordinary skill in the art at the time the invention was made that using multiple holes is an option to the single hole used in Strasbaugh, because Hofe teaches that both embodiments are within the purview of the artisan and an artisan would appreciate the advantages of each embodiment, choosing according for their desire function.

Regarding claim 3, as shown in Figure 5 of Hofe, each hole is surrounded by projections. The projections of the single hole embodiment are shown clearly in Figure 4.

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11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Strasbaugh as applied to claim 1 above.

Regarding claim 8, one of ordinary skill in the art would appreciate that a one-way valve could be used in Strasbaugh to create a vacuum, because various types of valves, including a one-way valve, are known to an artisan of ordinary skill and the artisan would know which type of valve to use based on their desired effect.

#### ***Allowable Subject Matter***

12. Claims 12-20 are allowed.

#### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new grounds of rejection.

#### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no

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event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
December 2, 2005